

## **RESPONSE**

### **A. Status of the Claims**

Claims 64-127 were pending at the time of the Restriction Requirement. Claims 83-127 are provisionally withdrawn from consideration at this time in view of the election of the Group I invention made below, with traverse, in response to the Restriction Requirement. Claim 64 has been amended, with support for the amendment being found in the specification at page 8, line 18 to page 9, line 2. Therefore, claims 64-127 are pending, with claims 64-82 presently under consideration. Further, if Applicants' traversal of the Restriction Requirement is accepted, then claims 83-127 are also under consideration.

### **B. Response to Restriction Requirement**

In response to the restriction requirement, Applicants elect, *with traverse*, to prosecute the Group I invention, as exemplified by claims 64-82 drawn to a composition.

Applicants contend, without prejudice, that claims 83-117 drawn to a process of transferring a coating from a support onto a surface of a thermoplastic material substrate (identified as the Group II invention), claims 118-125 drawn to an overmolding process (identified as the Group III invention), and claims 126-127 drawn to a process for making laminated thermoplastic articles (identified as the Group IV invention) should be examined in conjunction with claims 64-82 (the Group I invention). Applicants contend that the inventions of Groups I, II, III, and IV are linked as to form a single general inventive concept under PCT Rule 13.1 in that all of them involve the composition as defined in claim 64.

The inventions listed as Groups I, II, III, and IV relate to a single general inventive concept under PCT Rule 13.1 because they share at least one special technical feature that defines a contribution over the prior art (PCT rule 13.2). The mere fact that an international

application contains claims of different categories is in itself no reason for objection on the grounds of lack of unity of the invention (Chapter VII, 5 of the PCT Search Guidelines, PCT Gazette No. 30/1992, Sec. IV; No. 29/1993, Sec. IV).

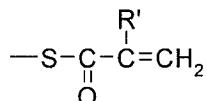
The expression “special technical features” is defined in Rule 13.2 as meaning those technical features that define in each claim a contribution which each of the inventions makes over the prior art (PCT Guidelines 10.01). Additionally, whether or not any particular technical feature makes a “contribution” over the prior art, and therefore constitutes a “special technical feature,” has to be considered with respect to novelty and inventive step (PCT Guidelines 10.02). Only then is it possible to decide whether or not a common special technical feature within the meaning of Rule 13.1 PCT and Rule 13.2 PCT exists for different inventions. Where, as in this case, there is no showing in the Restriction Requirement that a special technical feature of the process or product claims lacks novelty and/or non-obviousness, then it is not proper to state that there is no special technical feature linking the claims.

The Examiner has erroneously analyzed the Suyal *et al.* prior art in indicating that it discloses a composition within the scope of claim 64. Specifically, claim 64 as previously written, and even more clearly as currently amended, is novel and non-obvious over Suyal *et al.*, at least in part because Suyal *et al.* does not disclose at least a composition comprising a thio(meth)acrylate as required by claim 64 and defined in the specification.

Example 5 of Suyal *et al.*, as cited by the Restriction Requirement discloses a composition comprising:

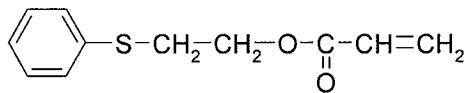
Phenyl thioethyl acrylate	1 g	20 %
Bisphenol-A-methacrylate	1.25 g	25 %
Hexane dimethacrylate	2.75 g	55 %

The composition of Example 5 does not contain a “thio(meth)acrylate” as defined in the present application or the claims. At page 8, line 18, to page 9, line 2, the specification defines



“thio(meth)acrylate” as a compound comprising an  $\text{S}-\text{C}(=\text{O})-\text{C}=\text{CH}_2$  function, wherein R' is H or  $-\text{CH}_3$ . Therefore, the thio(meth)acrylate of the claims comprises a function in which the S atom is directly linked to the carbonyl group of the (meth)acrylate function. In order to make it even clearer that the composition of claim 64 employs this definition of “thio(meth)acrylate,” Applicants have amended the claim to specifically recite the structure. However, given the definition in the specification, Applicants do not believe that this clarifying amendment changes the scope of claim 64.

Suyal *et al.* does not teach a thio(meth)acrylate as required by claim 64. On the contrary the phenyl thioethyl acrylate of Suyal *et al.* is the compound of formula:



In this regard, see paragraphs [0005] to [0008] of Suyal *et al.*, in which the S atom is linked through a  $-\text{CH}_2\text{CH}_2\text{-O-}$  moiety to the carbonyl of the acrylate function.

Consequently, the composition of claim 64 does effectively constitute a common inventive technical feature to all claims, and the “inventions” set forth in Groups I, II, III, and IV have a common inventive concept as required by PCT Rule 13.2, and Applicants request withdrawal of the Restriction Requirement and examination of all of the claims of Groups I, II, III, and IV in the present case.

Additionally, examination of all of the claims of Groups I, II, III, and IV should be performed together because a corresponding search would not present a “serious burden” on the examiner. MPEP § 803 (“If the search and examination of an entire application can be made

without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions"). Given the fact that there is a common inventive concept between the all of the claims, Applicants submit that there is no "serious burden" in examining the Groups I, II, III, and IV claims together in this case. Further, the examiner has provided no evidence of any serious burden.

In traversing the Restriction Requirement on the grounds set forth above, Applicants specifically take no position with regard to whether any sets of the present claims or any individual present claims are or are not patentably distinct from any other set of claims or individual claim. Rather, Applicants argue without acquiescence that, under the circumstances of this case and in view of the applicable PCT rules and statements of the MPEP, the stated restriction is not proper, whether those claims are patentably distinct or not. Such arguments do not create an estoppel against Applicants and are not an admission that the restricted Groups are either patentably distinct or patentably indistinct from one another.

In view of the above, Applicants request withdrawal of the Restriction Requirement between Groups I, II, III, and IV and examination of all of the claims of Groups I, II, III, and IV in the present case.

### **C. Rejoinder of Withdrawn Claims**

Applicants reserve any and all rights it may have, pursuant to the Rules and/or the statements of the Restriction Requirement, to have rejoined claims that have been withdrawn from prosecution in response to the Restriction Requirement upon allowance of claims in this application.

**D. Conclusion**

Applicants believe that they have submitted a complete reply to the Restriction Requirement dated June 5, 2009, and respectfully request favorable consideration of the claims in view of the statements contained herein.

Should the Examiner have any questions, comments, or suggestions relating to this case, the Examiner is invited to contact the undersigned Applicants' representative at (512) 536-3035.

Respectfully submitted,



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Date: August 5, 2009